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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/865,697	05/29/2001	Takehiro Yoshida	35.C15377	5737

5514 7590 09/22/2006

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EXAMINER

SAFAIPOUR, HOUSHANG

ART UNIT PAPER NUMBER

2625

DATE MAILED: 09/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/865,697

Applicant(s)

YOSHIDA, TAKEHIRO

Examiner

Houshang Safaipoor

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments filed on June 29, 2006 have been reviewed but they are not persuasive.

Applicant argues that "in the cited Kido facsimile device, while both sides of an original may be read, image data from a blank page is not stored" and further argues that in Kido device "...a structure for generating a blank page is required."

Storing or generating a blank page is not claimed by the applicant, however, Kido specifically discloses that "as a second effect [of the invention], in case a one surface original is transmitted, a blank surface is erroneously transmitted." (please refer to page 13, paragraph [0020]). Kido stores the images of both sides of the document and then transmits the data from the first and second memory (please refer to page 7, paragraph [0007]). Applicant further argues that there is no disclosure in the cited Edamura patent that "both side transmission mode is selected automatically..." This feature of the invention has not been claimed either. For the reasons stated, examiner maintains his previous rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yutaka Kido (JP 11-17877) and further in view of Edamura (U.S. Patent No. 5,408,340).

Regarding claim 1, Yutaka Kido discloses a facsimile apparatus for reading image data of a both-side original and transmitting it, comprising:

reading means for reading images on both sides of the original Page 9, [0011];

storing means for storing all of the image data read by said reading means (page 7, [0007])

discriminating means for discriminating whether effective image data is included on both sides of the original read by said reading means or not (page 11, paragraph [0015], lines 1-7);
and

Kido explains the reception mode (page 12) and does not explicitly disclose execution of a both-side transmission of the image data read from the both sides of the original if it is determined by said discriminating means that at least one sheet of original in which the effective image data is included on the both sides exists. In Edamura, the receiver recognizes two sided

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transmission by means of NSS signal from the transmitter (col. 5, lines 49-60). Edamura executes a one-side transmission of the image data read from a front side of the original in the other cases (col. 5, lines 3-9). Edamura also discloses that image memory 9 stores image information to be transmitted to an external facsimile device (fig. 2, col. 3, lines 54-55). As one of ordinary skill would have recognized, the ability of a transmitter to provide two-sided transmission enables a receiver to print on both sides of a recording sheet, thereby saving sheets. Therefore it would have been obvious to a person of an ordinary skill in the art to use Edamura's facsimile transmission control method in facsimile data transmission of Kido to transmit two sided document upon recognition of such document.

Regarding claim 2, Yutaka Kido discloses an apparatus according to claim 1, wherein even if at least one sheet of original in which the effective image data is included on the both sides exists, when a receiver on a partner side does not have a both-side transmission mode, only the sides including the effective image data are transmitted in order from the front side and a reverse side by using a one-side transmitting procedure (paragraphs [0015] and [0016]).

Regarding claim 3, Yutaka Kido discloses, an apparatus according to claim 1, further comprising operating means for designating a compulsory front side reading mode for reading only the image on the front side of the original, wherein when said compulsory front side reading mode is selected by said operating means, even if at least one sheet of original in which the effective image data is included on the both sides exists, only the front side of the original is read and the read image data is transmitted in a one-side mode (paragraphs [0015] and [0016]).

Regarding claims 4-6, arguments analogous to those presented for claims 1-3 are applicable to claims 4-6 respectively.

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Regarding claims 7-9, arguments analogous to those presented for claims 1-3 are applicable to claims 7-9 respectively.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Houshang Safaipoor whose telephone number is (571)272-7412. The examiner can normally be reached on Mon.-Thurs. from 6:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is (571)273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Houshang Safaipoor
Patent Examiner
Art Unit 2622
September 5, 2006



THOMAS D.
~~THOMAS~~ LEE
PRIMARY EXAMINER